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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/008,320

11/08/2001

Biao Ni

3286

7590

11/06/2006

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324 Hill Trail Drive  
Ballwin, MO 63011

EXAMINER

GREIMEL, JOCELYN

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/008,320

Applicant(s)

NI, BIAO

Examiner

Jocelyn Greimel

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/06</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This non-final action is in response to Applicant's application of November 08, 2001, which claims the benefit of 60/251,109 filed December 04, 2000. Claims 1-18 are pending and are presented to be examined upon their merits. Claims 1 and 13 are independent claims.

#### ***Specification***

2. The abstract of the disclosure is objected to because it exceeds the length limitation. Correction is required. See MPEP § 608.01(b).

3. The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 17 describe the "division of the amount of said rebate" which may or may not be needed. Some explanation is provided

in the specification for the division of the amount. However, it is not clear based upon the claims as recited and the Examiner has taken the best reasonable interpretation of "division of the amount" in the investment and matching accounts.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holmann (US Patent No. 5,787,404, hereinafter Fernandez), in view of Heise et al (US Patent Pub. No. 2003/0074229 A1, hereinafter Heise) and further in view of Gilbert et al (US Patent No. 6,041,313, hereinafter Gilbert).** In

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reference to claims 1 and 17, Fernandez discloses a method and system comprising the steps of:

a) establishing a credit based account with said sponsor for the benefit of said customer, or establishing a bank account with said sponsor for the benefit of said customer (col. 2, line 24 – col. 3, line 40);

b) providing an investment account employing said investment instrument arranged by said sponsor (col. 2, line 56 – col. 3, line 4; col. 4, line 45 – col. 5, line 2);

c) funding said investment account of said customer using said rebate offered by said sponsor with a predetermined but periodically adjustable percentage of total amount of money that said customer has paid for purchasing goods or services from a merchant through said credit based account or said bank account in a particular period of time (col. 5, line 48 – col. 6, line 3); and

d) electronically transferring the amount of said rebate in a particular period of time to said investment account of said customer (col. 2, line 56 – col. 3, line 40).

9. Fernandez does not disclose: electronically transferring a portion of the amount of said rebate in a particular period of time to said investment account of said customer and the rest of said rebate in a particular period of time to a match account, said match account employs the same said investment instrument as those selected by said customer for said investment account, if a division of the amount of said rebate is needed.

However, Heise discloses: electronically transferring a portion of the amount of said rebate in a particular period of time to said investment account of said customer and the rest of said rebate in a particular period of time to a match account, said match account employs the same said investment instrument as those selected by said customer for said investment account, if a division of the amount of said rebate is needed (0018; 0068; 0143; 0174-0175). It would have been obvious to one skilled in the art at the time of the invention to combine the transfer of a match amount as in Heise to the credit-based investment account of Fernandez as matching funds is a good way to get customers to continue using a company's product. Both Fernandez and Heise are financial systems utilizing investing techniques.

10. In reference to the dependent claims 2-12 and 14-18, Fernandez discloses: the steps a-d above and the steps of:

- Ascertaining the total amount of money charged to the credit based account or paid through the bank account by the customer for purchasing goods or services provided by the merchant in a particular period of time (col. 5, line 48 – col. 6, line 3);
- Calculating an amount of the rebate using the predetermined percentage based on the total amount of money charged to the credit based account or paid through the bank account by the customer in a particular period of time so ascertained (col. 5, line 48 – col. 6, line 3);

- Incorporating a statement of the calculated rebate of said period of time into existing periodic reports operated by the sponsor serving the credit based account or the bank account of the customer or reporting a statement of the calculated rebate of the period of time separately to the customer (col. 6, lines 4-20).

11. Or steps a-d above and including a specific rebate offered by the merchant to the customer for purchasing goods or services provided by the merchant comprising the steps of:

- ascertaining the total amount of money charged to said credit based account or paid through said bank account by said customer for purchasing goods or services provided by said merchant offering said merchant specific rebate in a particular period of time (col. 5, line 48 – col. 6, line 3);
- calculating an amount of said merchant specific rebate using a merchant specified percentage based on said total amount of money charged to said credit based account or paid through said bank account by said customer for purchasing goods or services provided by said merchant offering said merchant specific rebate in a particular period of time so ascertained (col. 4, lines 45-67; col. 5, line 48 – col. 6, line 3);
- subtracting the amount of said calculated merchant specific rebate from periodic credit to said merchant in a particular period of time; electronically transferring the amount of said merchant specific rebate in a particular period of time to said

investment account of said customer; and incorporating a statement of said calculated merchant specific rebate in a particular period of time into existing periodic reports operated by said sponsor serving said merchant; or reporting a statement of said calculated merchant specific rebate in a particular period of time to said merchant separately (col. 4, lines 45-67; col. 5, line 48 – col. 6, line 3; col. 6, lines 4-20).

12. Fernandez discloses the method and system where the investment instrument is a mutual fund, annuity, life insurance policy with imbedded cash value, certificate of deposit, security or another financial device, which accumulates monetary values over time (col. 1, line 5 – col. 3, line 40).

13. In reference to the claims regarding the matching account, Fernandez discloses specifically: instructing the investment service provider of the investment instrument to transfer funds from the match account to the investment account of the customer at their request or requiring the provider of the investment instrument to report to the customer regarding fund transfer from the match account to the investment account of the customer (col. 4, lines 45-57); establishing the match account only when the customer has maintained and made payments through the credit based account or the bank account for a period more or less than the predetermined number of years (col. 4, lines 58-66)..



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14. In reference to the claims regarding advertising of the investment account: it is well-known in the art to advertise promotions to garner new business via promotions such as: promoting the establishment of the investment account funded with the rebate; communicating the idea of funding the investment account using said rebate offered by the sponsor serving long term financial needs of the customer by (i) incorporating the promotion into existing periodic reports or (ii) marketing the promotion separately to reach the customer; or a specific rebate offered by the merchant to the customer for purchasing goods or services provided by the merchant which includes the above mentioned steps of ascertaining and calculating in addition to subtracting the amount of the calculated merchant specific rebate from periodic credit to the merchant in a particular period of time.

15. Fernandez does not explicitly disclose: presenting a table of a series of real case values of a constant annual rebate weighted by numeric factors depending on number of years that the customer holds the credit based account or the bank account with a valid account status, the table using the weighted numeric factors to determine the portion of the amount of the rebate in a particular period of time to be transferred to the investment account of the customer and the rest of the rebate in a particular period of time to be temporarily deposited into the match account if the division of the rebate is needed. However, it is well-known in the art of matching programs that the length of relationship between the company and the client can affect the match amount and various algorithms could be used to determine the amounts and factors.

16. The promotional material could include a table of expected future values of a constant annual rebate for various lengths of time period based on different assumed annual rates of return and a historic market average annual rate of return, the table reveals the fact of asset accumulation over time. This type of promotional material is well-known in the art to entice current or prospective clients to use the investment programs.

#### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached at (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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Jocelyn Greimel  
Examiner, Art Unit 3693  
October 27, 2006